

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 13 and 29 are requested to be cancelled.

Claims 1, 12, 14, 23, 30 and 36 are currently being amended.

No claims are being added at this time.

This amendment changes and deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-12, 14-28 and 30-37 are now pending in this application.

The present application was originally filed on December 21, 2001 with 32 claims. On August 27, 2002, a preliminary amendment was filed in which additional claims 33-35 were added. A second preliminary amendment was filed on September 24, 2003. In the second preliminary amendment, claim 1 was amended to eliminate an ambiguity in the claim language, and new claims 36 and 37 were added.

On October 6, 2003, the Examiner issued a first Official Action. However, the Examiner had yet to receive the September 24, 2003 preliminary amendment, in which a number of the issues raised by the Examiner had already been corrected. The Examiner subsequently agreed to reexamine the claims in light of the September 24, 2003 preliminary amendment. A new Official Action was issued on December 10, 2003, vacating the October 6, 2003 Official Action.

The Examiner rejected claims 13-15 under 35 U.S.C. § 112, second paragraph, due to an alleged ambiguity with the phrase "a plurality of grooves." In order to eliminate any potential ambiguity and in order to advance the prosecution of the present application, Applicants have

cancelled claim 13 and have amended claim 14 to be dependent upon claim 12. As claim 15 is already dependent upon claim 14, Applicants submit that the cancellation of claim 13 and amendment of claim 14 are sufficient to overcome the Examiner's rejections.

The Examiner rejected claims 1-9, 12-21, 23-28, 31 and 33-37 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,768,177, issued to Thomas, in view of U.S. Patent No. 5,511,472, issued to Taylor, and U.S. Publication No. 2002/009695, in the name of Rasheed et al. The Examiner has asserted that the Thomas reference teaches a base with pegs "capable of using as a base of an embossing system," while the Taylor reference teaches an embossing apparatus having upper and lower templates and other features, while the Rasheed et al reference teaches "texture plates" for creating textures on artworks. Claims 10, 11, 22, and 32 were rejected as being rendered obvious by the Thomas reference in view of the Taylor and Rasheed et al. references, and in further view of U.S. Patent No. 6,216,354, issued to Carbone, while the remaining claims were rejected as being unpatentable over the Thomas reference in view of U.S. Patent No. 4,309,825, issued to Geddes.

Notwithstanding the Examiner's assertions, Applicants respectfully submit that the claims as amended are patentable over the cited prior art.

Claim 1 has been amended to describe the plurality of shapes of the upper template as aligning with and being substantially identical to the plurality of shapes of the lower template when the posts and the regions of the second template and the lower template are in alignment, with the plurality of shapes of the lower template also being smaller in size than the corresponding plurality of shapes of the upper template.

Claim 12 has been amended to describe the at least one shape on one of the first template and the second template as being of a different size than the at least one shape on the other template.

Claim 23 has been amended to describe first and second templates, each of the templates including at least one substantially identical shape in substantially the same position on each of the templates, wherein the at least one shape on one of the first template and the second template is of a different size than the at least one shape on the other template. Claim 29, which described the shapes on the first and second templates as being of different sizes, has been cancelled.

Claim 36 has been amended to describe the second plurality of shapes of the second template as being larger in size than but substantially identical shape to the corresponding first plurality of shapes of the first template.

None of the references cited by the Examiner, either alone or in combination with each other, describe the features identified in any of the amended claims.

All of the currently pending claims as amended describe the respective templates as including at least one shape on the templates as being substantially identical in shape but different in size to each other. Paragraph 17 of the originally filed application describes the importance of this feature, namely that having a slight difference in size between the two shapes permits the user to “make an improved, more crisp embossment along the edge of the shape to be embossed.” This feature is not disclosed, taught, or even suggested in any of the prior art cited by the Examiner, alone or in combination with one another.

The Examiner cited the Geddes reference as disclosing a pair of templates whose shapes have different sizes. However, the Geddes reference does not disclose shapes of different sizes yet still substantially identical in shape. Instead, the Geddes reference discloses a pair of templates having different shapes to create particular letters of the alphabet. Importantly, when viewed in terms of the portion of the shape that is to be stenciled, the templates disclosed in the Geddes reference do not have the same shape. This is exemplified in Figure 4 of the Geddes reference, where it can be clearly seen that the “main stencil member 12” is used to stencil only the outline of the letter “A” while the “auxiliary stencil member 14” is used to only stencil the inner portion of the same letter. The present invention, on the other hand, claims the use of

templates having an identical shape, where both shapes are used to emboss the same edge. Furthermore, the concept of using the two templates in cooperation with each other in order to emboss the same edge is not taught, disclosed or even suggested by the Geddes reference.

Additionally, the Examiner is also directed to the fact that the templates described in the Geddes reference are to be used for stenciling and not embossing. Stenciling and embossing are entirely different processes, as stenciling involves creating an image or design on a material using a pencil or other writing implement, while embossing involves actually manipulating the material through an imprinting or a similar other function. This difference is exemplified by the fact that the stencils used in the Geddes reference are to be placed directly on top of a piece of material, while in the embossing process of the present invention, the sheet of material is placed between the two templates.

Additionally, none of the other references disclosed by the Examiner teach or suggest this same feature. For example, the Thomas reference is not even directed to an embossing system at all. The Taylor reference, on the other hand, does not disclose a pair of templates where the corresponding shapes are of different sizes, and there is no teaching or suggestion anywhere in the Taylor reference to do so.

It also would not have been obvious to combine the templates of the Taylor reference with those of the Geddes reference, as the templates in the Geddes reference are not used in the same manner as either the Taylor reference or the present invention. More particularly, both the templates of the Geddes reference are intended to rest on top of the material to be manipulated, rather than “sandwiching” the material. The present invention, on the other hand, is directed towards a system where the material is placed between the two templates in order to create a more crisp embossment. This is also true of the Taylor reference, making it completely unreasonable to assume that one would combine the Taylor and Geddes references in order to create a feature that neither reference contemplates.

The Examiner also cited the Rasheed, et. al. reference for the feature of using a texture plate for creating textures on artworks. However, the Rasheed, et. al. reference, like the Thomas reference, discloses neither templates having identical shapes, nor templates having shapes of difference sizes, much less templates having both of these features. Lastly, the Examiner cited the Carbone reference solely for the feature of providing grid patterns. However, the Carbone reference also is missing these key features regarding difference sizes but identical shapes on respective templates.

Lastly, Applicants also note that the Examiner has made several rejections by combining three and even four references. However, the Examiner has failed to identify within the patent references themselves any teaching or motivation to make these types of combinations. For example, the Examiner has cited the Thomas reference as including a base and a plurality of pegs and “capable of using as a base of an embossing system.” However, the Examiner has not pointed to anywhere within the patent that teaches or even suggests that such a combination could be made. Therefore, Applicants submit that, absent such teachings or suggestions, these combinations could only be made with the use of hindsight and are therefore improper. Applicants therefore respectfully request that the Examiner reconsider these three- and four-reference combinations.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1450. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit

Account No. 06-1450. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1450.

Respectfully submitted,

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